



Dw

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,266	05/02/2001	Muneomi Katayama	TESJ.0029	6117

7590 10/07/2002

REED SMITH HAZEL & THOMAS LLP
Suite 1400
3110 Fairview Park Drive
Falls Church, VA 22042

EXAMINER

SAADAT, CAMERON

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary	Application No.	Applicant(s)
	09/846,266	KATAYAMA, MUNEOMI
	Examiner	Art Unit
	Cameron Saadat	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16, 21 and 22 is/are rejected.
- 7) Claim(s) 17-20 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 May 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

In Response to the refund request filed on November 8, 2001, the amount of \$65.00 was credited to deposit account number 081480 on June 18, 2002.

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference sign "5" mentioned in the description.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference signs "I" and "P" mentioned in the description on Page 8.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" has been used to designate "mobile communication device", "video server", "mobile terminal", and "portable telephone terminal".

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "6" has been used to designate both "camera" and "plurality of cameras".

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

Specification

6. It appears that the instant application is a direct translation into English from a foreign document. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. In addition, the title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed, and the title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words. Correction is required.

Claim Objections

7. Claims 17-20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

10. Claims 1-4, 9-16, and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Regarding claim 1, the phrases "or the like" and "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore the acronyms "PDC" and "PHS" must be defined. In addition, the antecedent basis for "the data" and "the data and video data" has not been clearly set forth.

12. Regarding claim 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore, the antecedent basis for "the trainee" has not been clearly set forth.

13. Regarding claims 3 and 4, the antecedent basis for "the actions" has not been clearly set forth.

14. Regarding claims 1-4, the term "or/and" provides alternative choices and renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

15. Regarding claims 9-16 and 21-22, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in–
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in

section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

17. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ahlgren

(U.S. Patent No. 6,293,802 B1).

18. Referring to claim 1, as best understood, Ahlgren discloses a training method for moving a body in a sport using mobile image communication, comprising: a multi-functional, high-performance mobile image communication terminal 1602, a mobile network system (column 22, lines 40-56), a gateway for performing protocol conversion, and the Internet (column 22, lines 40-56); a plurality of cameras for photographing a body action of a trainer (column 7, lines 28-37), and a system for encoding video information of a camera to transfer encoded information to a video server (column 6, lines 21-27); a system which receives various pieces of information of the body action and transfers the data to a data server 112 (see Fig. 1). Wherein a user searches a data server with a mobile image communication terminal to view the data (column 10, lines 5-12).

19. Referring to claim 2, Ahlgren discloses a training method for moving a body in a sport using mobile image communication, wherein the data of the data server is data of a trainer which is displayed with the video image of a trainee, on the same screen for comparison, without being overlapped (column 15, lines 5-18).

20. Referring to claims 3 and 4, as best understood, Ahlgren discloses a training method for moving a body in a sport using mobile image communication, wherein a trainer prepares a lesson

plan comprising two still images that are simultaneously displayed and compared for the trainee to understand the difference between the two still images (column 15, lines 5-18).

21. Referring to claims 5-16, Ahlgren discloses a training method for moving a body in a sport using mobile image communication, wherein a trainer prepares a lesson plan wherein the image of the trainer is a moving image (column 15, lines 5-6) and the image of the trainee is a still image (column 15, lines 7-10).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. **Claims 21-22, as best understood by the examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlgren (U.S. Patent No. 6,293,802) in view of Barnard (6,456,938).**

Ahlgren discloses a training method for moving a body in a sport using mobile image communication wherein:

an action captured from two different locations is reproduced on a display without being overlapped and the two images are simultaneously compared with each other to help instruct a trainee (column 15, lines 5-18).

Although Ahlgren discloses that communications interface 1624 allows software and data to be transferred between computer system 1602 and external devices, the reference does not explicitly disclose that the external device is a mobile display. However, the reference does teach that interface 1624 is capable of wireless medium communication (column 22, lines 40-56) to external devices. Although the computer system 1602 is mobile in terms of communications, it does not seem to be physically mobile. However, it is the examiner's position that the feature of providing a physically mobile device comprising computing and display capabilities is old and well known. Furthermore, Barnard discloses a mobile image communication method comprising mobile display 28. Hence, in view of Barnard, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer system described by Ahlgren to provide a more physically mobile device, so that a trainee is free to move without being confined to one area for receiving feedback.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Katayama (U.S. Patent No. 5,947,742) – discloses a method of teaching body motions and overlaying lines on images.
- Katayama (U.S. Patent No. 5,857,855) – discloses a method of teaching body motions and overlaying lines on images.

Art Unit: 3713

- Easterbrook (U.S. Patent No. 5,823,786) – discloses a method of teaching body motions by placing images side-by-side for comparison.
- Dudley (U.S. Patent No. 5,772,534) – discloses portable display in a mobile network system.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS

September 27, 2002



VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
TELEPHONE: 703-308-4119
GY CENTER 3700